Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-35 are pending in the application, with claims 1, 9, 17, 25, and 31 being the independent claims. Claims 25-35 are withdrawn.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Election

On page 2 of the Office Action, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

I.   Claims 1-24, drawn to transferring scripts with objects to a mobile device, classified in class 709, subclass 203.

II.   Claims 25-35, drawn to using a script and an object to forward a mobile device to a second object and script, classified in class 709, subclass 227.

Applicants accordingly elect Invention I, including claims 1-24, without traverse.

Rejections under 35 U.S.C. § 103(a)

On page 3 of the Office Action, the Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No 6,311,058 to Wecker *et al.* (hereinafter Wecker) in view of U.S. Patent No. 6,366,137 to Lee (hereinafter Lee). For the reasons set forth below, Applicants respectfully traverse this rejection.

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The Office Action fails to establish a *prima facie* case of obviousness for at least the reason that Wecker and Lee, alone or in combination, fail to teach or suggest each and every feature of the claimed embodiments of the claimed invention. (M.P.E.P. § 2143).

Independent claim 1 recites:

> 1. A method of performing script operations for mobile devices, comprising the steps of:
> (1)   sending a request for at least one object;
> (2)   sending a list of supported script languages;
> (3)   receiving said at least one object; and
> (4)   receiving at least one script related to said at least one object.

Significant differences exist between the cited references and claim 1. Wecker does not teach all of the features of independent claim 1 recited above. For example, as stated by the Examiner on page 3 of the Office Action, Wecker does not teach or suggest "sending a list of supported script languages" as recited in claim 1. Furthermore Lee does not supply this teaching missing from Wecker.

Lee describes a client user interface that interacts with a remote server (abstract). The server described by Lee "obtains objects referred to by the tokens, by taking templates from the repository, inserting code, and sending the tokens the server and gateway to the browser or client. The tokens specifying the language of the request are embedded in the request from the client or browser", such as a URL (column 4, lines 40 - 48).

Thus, according to Lee, a request specifies a language of a request. This is not the same as "sending a list of supported script languages" as recited in independent claim

1. In short, a "language of a request is embedded in the request" recited by Lee is not the same as sending a *list* of supported script languages.

Lee also describes a server that is configured to receive requests from the client and send responses to the client. The server described by Lee "is further configured to interpret the request to determine at least one of the language, protocol or syntax in which the client sends requests and receives responses" (column 5, lines 27 - 31). On page 2 of the Office Action, the Examiner asserts that a request to a server includes "one or more specification about what language or script that the response should include". However, as mentioned above, the server described by Lee *interprets the request to determine the language.* This is *not* the same as "sending a *list* of supported script languages" as recited in independent claim 1. Thus, for at least these reasons, Lee does not teach or suggest sending a list of supported script languages, as recited in independent claim 1.

On pages 3-4 of the Office Action, the Examiner states:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Lee's teaching of informing the server of which language *or languages* the client is expecting in the servers response, in Wecker's system in order to optimize the communication and results between a client and a server by allowing the client to request a more appropriate response (Column 6, lines 46-67).

(emphasis added). Applicants take issue with this comment in the Office Action. Applicants respectfully request that the Examiner indicate where in Lee it is taught or suggested that the server is informed of multiple *languages* the client is expecting in the servers response. In Applicants' review of Lee, it was found that Lee merely stated "tokens *specifying the language* of the request are embedded in the request from the

client or browser" (col. 4, lines 43-45 of Lee) (emphasis added). Furthermore, Lee states "[t]he system . . . creates a response *in the preferred language, protocol, or syntax* of the client" (col. 5, lines 35-38 of Lee). Nowhere does Lee teach or suggest informing a server of *a list* of supported script languages.

Furthermore, the Examiner does not point to any suggestion or motivation in the references themselves for modifying Lee to relate to a list of supported script languages. However, "the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Nowhere in Lee and Wecker do Applicants find this desirability indicated.

In contrast, as described above, Lee teaches specifying the language of the request in the request. This *teaches away* from sending a list of supported script languages, as recited in claim 1, because the request of Lee specifically provides a language in which the server should respond. *Thus, there is no need to send a list of supported script languages in Lee*.

M.P.E.P § 2142 states:

> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicants assert that such a suggestion has not been clearly provided for combining Wecker and Lee, and further for modifying Lee as described above, but

instead a mere conclusion has been provided. Applicants note "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . ." In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992). Thus, Applicants respectfully request that a suggestion for combination and modification be provided, presenting a convincing line of reasoning, or that the claims be passed to allowance.

Because Wecker and Lee, alone or in combination, do not teach or suggest every limitation of claim 1, they cannot render that claim obvious. Thus, claim 1 is patentable over Wecker and Lee. For at least similar reasons as presented above with respect to claim 1, and further in view of their own respective features, claims 9 and 17 are also patentable over Wecker and Lee. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of independent claims 1, 9 and 17.

Furthermore, claims 2-8, which depend from claim 1, claims 10-16, which depend from claim 9, and claims 18-24, which depend from claim 17, are also patentable over Wecker and Lee for at least the reasons described above, and further in view of their own features. Thus, Applicants respectfully request that the rejection of these claims be reconsidered and withdrawn.

Because the rejection on page 3 of the Office Action discusses Lee, Applicants assume that the Examiner actually intended to refer to Lee in the rejection of the dependent claims 2-8, 10-16 and 18-24 on pages 4 and 5 of the Office Action, and have analyzed the Office Action as such. Notwithstanding this, Applicants assert that McLain does not provide the missing teachings, and that claim 1-24 are patentable over Wecker, Lee and McLain.

Accordingly, the Examiner's rejection of claims 1-24 under 35 U.S.C. § 103(a) is traversed and Applicants respectfully request that these rejections be withdrawn.
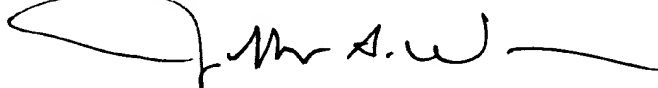
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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